

Appl. No. 09/954,874
Response dated January 5, 2005
Reply to Office Action of October 05, 2004

Remarks/Arguments

Claims 17-28 and 30-44 are presented for Examiner Salvatore's consideration. Claims 1-16 and 46-47 are previously withdrawn, and claims 29 and 45 are previously canceled. Applicants thank the Examiner for entry of the amendments to claims 17 and 30 that were requested in Applicants' paper mailed August 23, 2004.

Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the following remarks is respectfully requested.

By way of the section numbered 3 of the Office Action mailed October 5, 2004, the Examiner rejected claims 17-28 and 30-44 under 35 U.S.C. § 103(a) as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 6,186,320 to Drew (hereinafter "Drew") in view of U.S. Patent Number 5,709,735 to Midkiff et al. (hereinafter "Midkiff et al."). This rejection is respectfully **traversed** to the extent that it may apply to the currently presented claims.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143. Applicants submit that a *prima facie* case of obviousness has not been established both because, as described below, there is no motivation to combine the cited references, and because the cited references, even if combined, fail to teach or suggest at least two of the claims limitations.

As the Examiner has noted, Drew teaches a double sided storage sleeve comprising a flexible first sheet, a flexible third sheet, and a flexible nonwoven, non-laminated second sheet positioned between the first and third flexible sheets. In addition, as the Examiner has noted, Midkiff et al. teaches a high stiffness nonwoven filter medium. The Examiner has combined Drew and Midkiff et al. and the Applicants reiterate their assertion that that one skilled in the art would not be motivated to make such a combination. The Examiner has stated that one skilled in the art would be motivated to do so by the desire to provide a storage sleeve having sufficient structural integrity. However, the Examiner has not shown why she believes the structural integrity of the Drew storage sleeve to be insufficient, or where, in the teachings of the references, one skilled in the art would

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find such insufficiency of structural integrity. Applicants again submit that one skilled in the art would be led away from, not toward, replacing the flexible nonwoven of Drew with a high stiffness nonwoven. These two concepts are at opposite ends of a spectrum, and therefore one skilled in the art would not be lead to reach for a stiff material as a substitute where a flexible material was specified, nor to reach for a flexible material as a substitute where a stiff material was specified. The Examiner has asserted that Midkiff et al. teaches employing the nonwoven (i.e., the high stiffness nonwoven filter medium taught therein) for other applications such as towels, and asserts that therefore when the nonwoven is used as a towel the stiffness would vary. Applicants point out that the section of Midkiff et al. relied upon by the Examiner, which mentions uses such as towels, is the Background section (please see Midkiff et al. at Col. 1 lines 15-19). As such, this statement is no more than a general statement regarding general uses for nonwoven fabrics. Midkiff et al. does not in any way appear to suggest that the high stiffness nonwoven filter medium that it teaches could be useful for these other (low stiffness) uses such as towels.

In any event, Applicants respectfully submit that even if there does exist motivation to combine these two references, still, when combined together, these references fail to teach or disclose all of the parameters of Applicants' invention as presently claimed in claims 17-28 and 30-44.

The invention as presently claimed in amended claim 17 is directed to a storage sleeve for holding an article having a sensitive surface to protect the sensitive surface from damage. The storage sleeve comprises a first web having a top edge, a bottom edge and two side edges and, a second web comprising a nonwoven web comprising multicomponent thermoplastic polymer filaments bonded in a pattern having continuous bonded areas defining a plurality of discrete unbonded areas, the nonwoven web having a bulk density in the range of about 0.075 g/cc to about 0.130 g/cc and a Gurley stiffness greater than about 80 mg and having a top edge, a bottom edge and two side edges, and wherein the first web is interconnected with the second web at or near the bottom edge and two side edges of the first web to form a pocket to hold said article having a sensitive surface.

Applicants submit that even if one skilled in the art were to replace the flexible second sheet of Drew with the high stiffness nonwoven of Midkiff et al., such a combination still fails to teach or suggest each and every element of the Applicants' claims, first by failing to teach the element of the nonwoven web having a bulk density in the range of about 0.075 g/cc to about 0.130 g/cc, and

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second by failing to teach the element of bonding in a pattern having continuous bonded areas defining a plurality of discrete unbonded areas.

First, regarding the bulk density limitation in claim 17, the Examiner has cited *In re Boesch*, 617 F.2d 272, 276; 205 USPQ 215, 219 (CCPA 1980) to support the argument that the bulk density, although not stated in the references, is a result effective variable within the skill of the art to optimize to such a range as that recited by Applicants' claims. However, the rule recited in *In re Boesch* applies where such a variable that is optimized is recognized to be a result effective variable. Please see M.P.E.P. 2144.05(II)(B) citing *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (Cust. & Pat.App.1977) ("A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation."). Here, Applicants have not carved out some narrower range from within some larger or overlapping range which is taught by the cited art -- the art cited does not appear to describe any bulk density ranges. Therefore, it is not proper to simply conclude that the untaught bulk density range is obvious as a result effective variable that was optimized.

Second, regarding the element of bonding in a pattern having continuous bonded areas defining a plurality of discrete unbonded areas, the Examiner has stated that Midkiff et al. teaches using various patterned calender rolls to produce patterned bonded areas which disclose the Applicants' claims (Midkiff et al. at Column 5, lines 1-37). However, the bonding taught by Midkiff et al. is thermal point bonding, which produces discrete bond points, also called "spot bonding" as stated in Midkiff et al. However, the Applicants' claims require that there be continuous bonded areas defining a plurality of discrete unbonded areas. As described in the application specification at page 9 line 25 through page 10 line 8, this "point unbonding" is quite different and distinct from the point bonding described in Midkiff et al. As described in the application specification, instead of having the discrete bonded areas (as in thermal point bonding), instead there are discrete unbonded areas which are encircled, or surrounded, by the continuous bonded areas. By way of illustration, the unbonded areas may be thought of a similar to islands in water, where the water represents the bonded areas which define the unbonded island by encircling or surrounding it. In contrast and using the same illustration, in thermal point bonding as described in Midkiff et al., the unbonded areas would be the water surrounding the bonded island points. For this reason, the

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combination of Drew with Midkiff et al. does not teach the claim element of bonding in a pattern having continuous bonded areas defining a plurality of discrete unbonded areas.

Applicants believe the dependent claims 18-28 and 30-44, which depend either directly or indirectly from independent claim 17, recite the present invention in varying scope and further define the invention. Applicants have herein discussed the cited references in relation to independent claim 17. Claims 18-28 and 30-44 are similarly distinguishable not only because of the patentability of the independent claim but also because of the combination of the subject matter of each of the dependent claims with the independent claim which makes each claim further distinguishable.

Because there is no motivation to combine the cited references, or, alternatively, even if Drew and Midkiff et al. are combined, the combination still fails to disclose at least two of the parameters required by Applicants' claims, Applicants submit that a *prima facie* case of obviousness has not been set forth. For these reasons, Applicants submit that the rejection claims 17-28 and 30-44 under 35 U.S.C. §103(a) over Drew in view of Midkiff et al. should be withdrawn, and it is respectfully submitted that all of the presently presented claims are in form for allowance.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: 770-587-8908.

Respectfully submitted,

SINGER ET AL.

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CERTIFICATE OF FACSIMILE TRANSMISSION

I, Robert Ambrose, hereby certify that on January 5, 2005, this document is being faxed to the United States Patent and Trademark Office, central facsimile machine at (703) 872-9306.

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